

Application No.: 10/559,098  
Filing Date: January 10, 2007

## REMARKS

Claims 1-26 and 35-38 are pending. Applicants have cancelled Claim 3 without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to prosecute the subject matter of the cancelled claim in this or any other application.

Claims 1-4, 7 and 8 were examined and were rejected by the Examiner in the Office Action. Applicants respond below to the specific rejections raised by the Examiner. For the reasons set forth below, Applicants respectfully traverse.

### Claim Objections - 37 C.F.R. § 1.75(c)

The Examiner has objected to Claim 3 as allegedly being in improper dependent form for failing to further limit the subject matter of a previous claim.

While not acquiescing to the Examiner's assertion, and solely for the purpose of expediting the prosecution of the instant case, Applicants have cancelled Claim 3, thereby rendering the Examiner's objection moot. Applicants respectfully request reconsideration and withdrawal of the rejection accordingly.

### Rejection Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 1-4 under 35 U.S.C. § 103(a) as allegedly being unpatentably obvious over International Patent Application Publication WO 02/071735 to Leclerc et al. in view of Gold et al. (1995) *JBC* 270:13581-13584. According to the Examiner, Leclerc et al. teach polythiophene derivative complexes for the detection of an acidic protein. According to the Examiner, the acidic protein is detected by contacting a target complementary to the protein with the polythiophene derivative and detecting a change as an indication of the presence of the protein, wherein the target is a nucleic acid. The Examiner states that Leclerc et al. do not specifically teach that the target is an aptamer. However, the Examiner states that Gold et al. teach that aptamers are single-stranded DNA molecules that interact with target molecules. According to the Examiner, it would have been obvious to substitute the specific nucleic acid (aptamer) in place of the DNA in Leclerc et al.'s DNA polythiophene complexes for the purpose of detecting a target protein.

Applicants respectfully traverse. Section 102 of 35 U.S.C. defines categories of prior art that are available under 35 U.S.C. § 103. The primary reference relied upon by the Examiner in

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the rejection under 35 U.S.C. § 103(a) does not qualify as prior art under 35 U.S.C. § 102. In particular, in order for a printed reference (*e.g.*, an International Patent Application Publication such as WO 02/071735), to qualify as prior art under 35 U.S.C. § 102(a), the printed publication must be published *before the invention thereof by the applicant for patent*. As such, the patent or printed publication must be from an inventive entity different than the inventive entity of the application at issue. The following individuals are listed as inventors on the primary reference relied upon by the Examiner (WO 02/071735): Mario Leclerc, Hoang-Anh Ho, and Maurice Boissinot. The same individuals are listed as the inventors of the instant application. Therefore, WO 02/071735 does not qualify as prior art under 35 U.S.C. § 102(a).

Under 35 U.S.C. § 102(b), patents or printed publications that have published in this or a foreign country *more than one year prior to the date* of the application for patent in the United States are prior art. WO 02/071735 was published on October 17, 2002. The instant application claims priority to U.S. Application No. 60/474,950 filed June 3, 2003 and to CA 2,430,910 filed June 3, 2003. As October 17, 2002 is not more than one year prior to the effective filing date of the instant application, WO 02/071735 is not available as prior art under 35 U.S.C. § 102(b).

Prior art under 35 U.S.C. § 102(d) consists of patents or inventor's certificates that issued from an application filed more than twelve months before the filing of the application in the United States by the applicant, his legal representatives or assigns in a foreign country. WO 02/071735 is not a patent or inventor's certificate, and therefore is not prior art under 35 U.S.C. § 102(d).

Prior art under 35 U.S.C. § 102(e) refers to published patent applications *by another*, or patents granted on an application *by another* before the invention by the applicant. As set forth above in reference to 35 U.S.C. § 102(a), WO 02/071735 is not a published patent application *by another*. Rather WO 02/071735 and the instant application list the same individuals as inventors. Accordingly, WO 02/071735 is not prior art under 35 U.S.C. § 102(e).

35 U.S.C. § 102(c), (f) and (g) are not applicable to publications, or publications with the same inventive entity. As such, WO 02/071735 is not prior art under 35 U.S.C. § 102(c), (f), or (g).

For the reasons set forth above, WO 02/071735 is not prior art under 35 U.S.C. § 102. Since the primary reference relied upon by the Examiner in support of the rejection under 35

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U.S.C. § 103(a) is not available as prior art, Applicants respectfully request reconsideration and withdrawal of the rejection.

**Terminal Disclaimer**

In the interest of advancing prosecution of the instant case, Applicants submit herewith a terminal disclaimer, disclaiming any patent term that would extend beyond the term of U.S. Patent No. 7083928, or any patent that issues from U.S. Patent Application No. 11/370,158. U.S. Patent No. 7083928 corresponds to the U.S. Patent that issued from the National Stage Application of PCT/CA02/00485, which published as WO 02/071735. U.S. Patent Application No. 11/370,158 is a divisional of, and claims priority to, U.S. Application No. 10/474,230, which issued as U.S. Patent No. 7083928.

**No Disclaimers or Disavowals**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

**CONCLUSION**

In view of the above amendments and remarks, Applicants respectfully maintain that the claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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